

### **REMARKS/ARGUMENTS**

The foregoing amendments in the specification and claims are of a formal nature, and do not add new matter.

Applicants note and appreciate the withdrawal of the earlier rejections under 35 U.S.C. §112, first paragraph and second paragraph.

Prior to the present amendment, Claims 58-65, 68-70 and 74-84 were pending in this application and were rejected on various grounds. With this amendment, Claims 58-62, 64-65 and 79-84 have been canceled without prejudice and Claims 63, 74, 76 and 78 have been amended to clarify what Applicants have always regarded as their invention.

Claims 63, 68-70 and 74-78 are pending after entry of the instant amendment. Applicants expressly reserve the right to pursue any canceled matter in subsequent continuation, divisional or continuation-in-part applications.

#### **Claim Rejections – 35 U.S.C. §112, Second Paragraph**

Claims 58-65, 68-70 and 74-77 are rejected under 35 U.S.C. §112, second paragraph, for allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In particular, the Examiner notes that "Claim 58 has been amended such that preamble recites 'An isolated nucleic acid encoding a polypeptide', however, part (c) of the claim required the polypeptide to have identity to a nucleic acid sequence. As polypeptide do not have identity to nucleic acids, the claim is indefinite. Claims 59-63 are similarly indefinite."

Applicants respectfully disagree and traverse the rejection.

Without acquiescing to any of the rejections, Applicants submit that the cancellation of Claims 58-62 and 64-65 renders the rejection of these claims moot. Furthermore, Claim 63 (and, as a consequence, those claims dependent from the same) does not require the polypeptide to have identity to a nucleic acid sequence. Accordingly, Applicants request that the rejection of Claims 63, 68-70 and 74-77 under 35 U.S.C. §112, second paragraph, be withdrawn.

#### **Claim Rejections – 35 U.S.C. §112, First Paragraph (Enablement)**

Claims 58-65 and 74-77 remain, and Claims 78-84 are rejected under 35 U.S.C. §112, first paragraph, allegedly because "the specification, while being enabling for the nucleic acid of

SEQ ID NO: 205 or fragments of such that are usable as hybridization probes, does not reasonably provide enablement for nucleic acids 80, 85, 90, 95 or 99% identical to such, nor which encode a protein 80, 85, 90, 95 or 99% identical to the protein of SEQ ID NO:205, nor nucleic acids which hybridizes to any of the above."

Without acquiescing to any of the rejections, Applicants submit that the cancellation of Claims 58-62, 64-65 and 79-84 renders the rejection of these claims moot. Furthermore, as amended, Claim 63 (and, as a consequence, those claims dependent from the same) does not recite degenerate variants of SEQ ID NO:205.

The Examiner further asserts that Claims 78-84 "do not require that the claimed nucleic acid be amplified in lung or colon tumors.... The newly introduced claims seek coverage of any nucleic acid that could be obtained under specified conditions using the disclosed nucleic acids...."

Without acquiescing to the Examiner's position in the current rejections, Applicants have amended Claim 78 to recite, "An isolated nucleic acid molecule consisting of an at least 100 nucleotides fragment of the nucleic acid sequence of SEQ ID NO:205, or a complement thereof, that specifically hybridizes under stringent conditions to ...." Therefore, as amended, Claims 78 does not seek coverage of any nucleic acids that could be obtained under the specified stringent conditions, but claims a fragment of SEQ ID NO:205, or complement therefore. As the Examiner has admitted, the specification is "enabling for the nucleic acid of SEQ ID NO:205 or fragments of such that are usable as hybridization probes."

Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the present rejections under 35 U.S.C. §112, first paragraph.

**Claim Rejections – 35 U.S.C. §112, First Paragraph (Written Description)**

Claims 58-65 and 74-77 remain, and Claims 78-84 are rejected under 35 U.S.C. §112, first paragraph for alleged lack of sufficient written description.

Without acquiescing to any of the rejections, Applicants submit that the cancellation of Claims 58-62, 64-65 and 79-84 renders the rejection of these claims moot. Furthermore, as amended, Claim 63 (and, as a consequence, those claims dependent from the same) does not recite variants of SEQ ID NO:205.

Accordingly, Applicants respectfully submit that one skilled in the art would readily recognize that the Applicants were in the possession of the invention claimed at the effective filing date of this application. Hence, Applicants respectfully request the Examiner to reconsider and withdraw the present rejections under 35 U.S.C. §112, first paragraph..

#### **Claim Rejections – 35 U.S.C. §102**

Claims 78-83 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Matsubara *et al.*, WO 95/14772. Applicants respectfully submit that the cancellation of Claims 79-83 renders the rejection of these claims moot. Furthermore, Claim 78 has been amended to recite, "An isolated nucleic acid molecule consisting of an at least 100 nucleotides fragment...." Accordingly, Applicants respectfully submit that Claim 78 is not anticipated by Matsubara *et al.* Hence, the present rejection should be withdrawn.

#### **CONCLUSION**

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited. Should there be any further issues outstanding, the Examiner is invited to contact the undersigned attorney at the telephone number shown below.

Please charge any additional fees, including fees for additional extension of time, or credit overpayment to Deposit Account No. **08-1641** (referencing Attorney's Docket No. **39780-2630 P1C73**).

Respectfully submitted,

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